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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,579	08/28/2001	Kanji Matsutani	NAK-059-USA-P	3239

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10/03/2003

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EXAMINER

DAVIS, DANIEL J

ART UNIT PAPER NUMBER

3731

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/939,579

Applicant(s)

MATSUTANI ET AL.

Examiner

D. Jacob Davis

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "Arc-like" is indefinite since it is not clear whether the shape is actually in the form of an arc or not.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,713,915 to Van Heugten et al. Van Heugten discloses an ophthalmologic knife comprising a handle 82 and an end portion 46 (Fig. 15). The end portion 46' (Figs. 12 and 14) comprises a blade portion 54', a front tip, cutting edges 58', 60', and a guide portion 66', 68', 70', 72'. Fig. 14 illustrates the wedge shaped cross sectional slope on

both the top and bottom surfaces. Fig. 12 illustrates that the guide portion 70', 72' is slanted towards the tip at a greater angle than the cutting edges 58' and 60' are.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Heugten. Van Heugten gives no importance to the inclination angles of the top and bottom surfaces. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to design the inclination angles of the bottom surface of the guide portion to be greater than the top surface (or at any angle) to effectively and safely incise tissue.

Claims 5, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of U.S. Patent No. 5,713,915 to Van Heugten et al. Applicants disclose in Figs. 8 and 9 a blade portion 55, a front tip 55b, two cutting edges 55a, and a guide portion 55b, 55c, 55d. If 55c represents a top surface of the guide portion, the guide portion further includes a flat bottom surface as seen in Fig. 9, which is perpendicular to 55b.

The bottom surface, as illustrated, does not have an inclination angle. Instead of simply entering the primary incision for widening, the flat surface of the prior art device is in greater danger of snagging on the sides of the incision and forming an additional cut where the practitioner had not intended. An inclined angle reduces the likelihood that guide portion will snag on the eyeball. If an inclined surface were to nick a side of the insision, the device would simply be guided into position within the incision. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the prior art device to enable the knife to enter the tissue more smoothly and easily, without snagging on the sides of the incision.

The guide portion has an arc portion and a straight portion as illustrated in Fig. 8.

The prior art disclosed by applicants fails to disclose the use of reflection treatment prevention on the surface of the blade. Nevertheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a reflection preventive treatment on the surface of the blade to avoid temporarily reflecting too much light in the eyes of a surgeon and momentarily incapacitating him.

### ***Response to Arguments***

Applicant's arguments filed 7/21/03 have been fully considered but they are not persuasive. As pointed out by applicants, the Van Heugten device discloses that elements 58' and 60' are "longitudinal edges." He is silent in the specification as to the sharpness of the edges. Applicants claim "cutting edges." "Cutting edges" is considered a functional limitation. As such, even if the longitudinal edges 58' and 60'

disclosed by Van Heugten are not as sharp as his "cutting edges" 62' and 64', they are still capable of cutting tissue if sufficient force is supplied to the edge.

The faces and/or the edges of Van Heugten's cutting edges may be considered the guide portion. Van Heugten's guide portion is capable of "guiding the blade portion into the incision formed at the eyeball."

Examiner agrees with applicants' arguments regarding the rejection of claim 9, but are moot in view of the new grounds of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

DJD  
September 30, 2003

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700